

REMARKS

Statement of the Interview

Applicants thank the Examiner for the opportunity to discuss the case on January 27, 2011. During the Interview, the undersigned attorney discussed the rejected claims with the Examiner, requesting withdrawal of the obviousness-type double patenting rejection. No agreement was reached.

Claim Rejections for Double Patenting

The Examiner maintained the provision rejection of claims 1 and 3 as being unpatentable over claims 1-10 and 13 of co-pending application number 10/522,207 (the '207 application) on the ground of non-statutory obviousness-type double patenting. The final rejection mailed on December 7, 2010 only noted that claims 1 and 3 were being provisionally rejected for obviousness-type double patenting and claim 20 is allowable. The Examiner, however, noted in the interview summary mailed on February 3, 2011, that claims 1, 3 and 20 have been rejected for non-statutory obviousness-type double patenting. Applicants respectfully request clarification from the Examiner as to whether claim 20 has also been rejected.

Applicants first note that the response filed on July 6, 2010 does, in fact, contain an error made by the undersigned attorney. The undersigned mistakenly (without any deceptive intent) read that the benzyl substituent on the piperidine ring of the compound of formula I of the '207 Application is allowed to be a number of substituents, but failed to see substituents F, Cl, Br, CF₃, OCF₃, OR³ and C₁₋₆alkyl group. The undersigned now corrects that statement and agree that the R substituent of the compound of Formula I of the '207 Application may be -C₁₋₃alkyl Ar¹ wherein the Ar¹ phenyl may optionally be substituted with one or more additional substituents selected from, among others, OR³ wherein R³ may be H or C₁₋₆alkyl. As such, the compound of claim 1 of the '207 application generically covers the compound of claim 1 of the current application. Nevertheless, Applicants respectfully disagree that the current claims are obvious over those of the '207 Application.

As previously argued, it is well established that a disclosure of a generic formula does not by itself render obvious a species of that genus. *See In re Baird*, 16 F.3d 380, 382 (Fed. Cir. Jan.

19, 1994) ('The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.') (citing *In re Jones*, 958 F.2d 347, 350 (Fed. Cir. 1992); *See also* MPEP 2144.08. The Court also noted that, “[a] disclosure of millions of compounds does not render obvious a claim to three compounds, particularly when that disclosure indicates a preference leading away from the claimed compounds.”. *In re Baird*, 16 F.3d at 383. Here, while it is true that the ‘207 Application generically covers the compounds of the currently claimed invention, this fact alone does not render the claims of the current application obvious and patentably indistinct.

In particular, MPEP 804, Paragraph II.B.1 provides that the analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. In addition, “any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent.”

Id. (emphasis added). Therefore, similar to the obviousness analysis, the Examiner is required to make clear why a person of ordinary skill in the art would conclude that the rejected invention is obvious in view of another patent or application.

In this case, the Examiner continues to argue that the difference between an obviousness analysis and an obviousness-type double patenting analysis is that in the latter, the comparison is between the claims of the reference and the claims of the current application. Applicants note, however, that even comparing claim 1 of the ‘207 Application to claim 1 of the current application, nothing in claim 1 of the ‘207 Application suggests that specifically pentyloxy substitution on, specifically, the C_1 alkylAr¹ is preferred among all of the substituents disclosed. In looking at claim 1 of the ‘207 Application, the R substituent may be a $-C_{1-3}$ alkylAr¹. The Examiner did not explain why, out of a $-C_{1-3}$ alkylAr¹, the $-C_1$ alkylAr¹ should be selected and, out of the large selection of what aryl may be substituted with (e.g., CN, CON(R¹)₂, SO_nR², SO₂N(R¹)₂, F, Cl, Br, CF₃, OCF₃, OR³ and C₁₋₆alkyl, etc.), why one skilled in the art would

select OR³, and out of the options for R³, why pentyl should be selected and not H or C₁, C₂, C₃, C₄ or C₆alkyl. Further, in comparing claim 1 of the current application to claims 2-11 of the ‘207 Application, the Examiner still has not explained why it would be obvious for one skilled in the art to select the (4-pentyloxy)phenyl)methyl substituent out of the substituents claimed in claims 2-11 of the ‘207 Application. Therefore, Applicants respectfully submit that the Examiner has not met her burden of showing *prima facie* obviousness to support the non-statutory obviousness type double patenting rejection of the claims of the current invention based on the claims of the ‘207 Application. The Examiner can only find obviousness-type double patenting in this case by starting the analysis with the forbidden use of hindsight knowledge of the currently claimed invention (compound of claim 1 of the current application). In addition, Applicants note that the obviousness-type double patenting rejection is premature as the claims in the ‘207 application has not been issued yet and may change in the course of prosecution. In view of the arguments made, reconsideration and withdrawal of this rejection is again earnestly and respectfully requested.

This response is filed within two months from the date of the mailing of the final office action dated December 7, 2010, which response is due February 7, 2011, it is believed this response is timely and no fees are required. If this is not correct, however, please charge any additional fees, or credit any overpayment, to Deposit Account No. 50-4255

Respectfully submitted,

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